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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,194	09/08/2003	Hisayasu Nakao	1046.1299	8380
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HAMZA, FARUK	
			ART UNIT 2455	PAPER NUMBER
			MAIL DATE 01/21/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/656,194

**Applicant(s)**

NAKAO, HISAYASU

**Examiner**

FARUK HAMZA

**Art Unit**

2455

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-11, 14,16-19,21-27,29-37,40,42-53,55-63,66,68-78 and 101-104 is/are pending in the application.
- 4a) Of the above claim(s) 23-26,49-52,75-78 and 101-104 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11, 14,16-19,21,22,27,29-37,40,42-48,53,55-63,66 and 68-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of Priorities Cited (PTO-402)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/9/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This action is responsive to the amendment filed on October 7, 2009. Claims 1, 14, 27, 40, 53 and 66 have been amended. Claims 2, 12-13, 15, 20, 28, 38-39, 41, 54, 64-65, 67 and 79-100 have been canceled. Claims 23-26, 49-52, 75-78 and 101-104 have been withdrawn. The applicant is respectfully requested to cancel the withdrawn claims. Claims 1, 3-11, 14, 16-19, 21-27, 29-37, 40, 42-53, 55-63, 66, 68-78 and 101-104 are pending.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 3-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, it recites "a test mail" in line 9 and 12. It is unclear to the examiner whether these are referring to the same test mail. It recites "a response" in line 10 and in line 12. It is unclear to the examiner whether these are referring to the same response. Also it is unclear and vague to the examiner what applicant meant by "wherein said confirmation includes confirming whether or not the response conforms with the response step".

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 27, 29-40 and 42-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 27 and 40, it is a method claim and thus must meet the particular machine or transformation test as set forth in *Bilski*. In this case, there is no particular machine or particular transformation. Rather, the claim seems to consist entirely of software which is not patentable per se. Dependent claims do not recite any particular machine or transformation that would render the claims patentable subject matter. Therefore, they are rejected based on their dependency.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-11, 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubik et al. (U.S. Patent Number 6,775,691) hereinafter referred as Kubik and further in view of Tsukui et al. (U.S. Patent Number 6,557,045) hereinafter referred as Tsukui.

As to claim 1, Kubik teaches an E-mail management system for managing a forward destination of an E-mail, the E-mail management system including a processor, the processor programmed to execute:

accepting a setting request of a forward destination address corresponding to a receipt address of an E-mail addressed to the receipt address and the E-mail being to be forwarded to the forward destination address (abstract); and

executing a confirmation of a validity of the forward destination address to which the E-mail addressed to the receipt address is forwarded, by sending a test mail to the forward destination address and receiving a response to the test mail (abstract, Column 1, lines 55-64, Column 7, lines 55-Column 8, lines 30); and disclosing a response to a test mail (Column 7, lines 52-55);

wherein said confirmation includes confirming whether or not the response conforms with the response step (Column 7, lines 47-55).

Kubik does not explicitly teach the claim limitation of an address within a predetermined range.

However, Tsukui teaches the claim limitation of an address within a predetermined range (Column 6, lines 55-60).

It would have been obvious to the ordinary skill in the art at the time of the invention to modify the system of Kubik by incorporating Tsukui's teaching of managing e-mail addresses into an upper hierarchical domain name and lower

hierarchical domain name because it would reduce the number of characters to be input by an operator and therefore make the system more efficient.

As to claim 3, Kubik teaches an E-mail management system according to claim 1, the processor further programmed to execute: commanding a sending device to send a test mail to the forward destination address; and communicating with a receiving device to receive a response to the test mail, wherein said confirmation includes confirming the validity of the forward destination address by the response received by said receiving device (Column 7, lines 55-Column 8, lines 30).

As to claim 4, Kubik teaches an E-mail management system according to claim 1, further programmed to execute: registering the forward destination address corresponding to the receipt address if the confirmation proved successful; and forwarding a received E-mail addressed to the receipt address to the forward destination address, when the forward destination address corresponding to the receipt address is registered (Column 7, lines 55-Column 8, lines 30).

As to claim 5, Kubik teaches an E-mail management system according to claim 1, communicating with a mail server which registers the forward destination address corresponding to the receipt address of the E-mail, and forwards the received E-mail addressed to this receipt address to the forward destination address, wherein said confirming unit commands if the confirmation proved successful, said mail server to register the forward destination address

corresponding to the receipt address via said communication unit (abstract, Column 1, lines 55-64).

As to claim 6, Kubik teaches an E-mail management system according to claim 2, wherein said confirming unit confirms whether or not the response is transmitted from the receipt address (Column 7, lines 55-Column 8, lines 30).

As to claim 7, Kubik teaches an E-mail management system according to claim 1, wherein said confirmation confirming includes sending test mails respectively to the receipt address and the forward destination address, and confirming responses to these two test mails (Column 7, lines 55-Column 8, lines 30).

As to claim 8, Kubik teaches an E-mail management system according to claim 4, the processor further programmed to execute: registering a forward destination address unconditionally in response to said setting request for setting the forward destination address that is within a predetermined range, and registering a forward destination address with respect to which the confirmation by said confirming unit proved successful in response to said setting request for setting the forward destination address that is beyond the predetermined range (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 9, Kubik teaches an E-mail management system according to claim 1, further comprising a notifying unit notifying that a permission of forwarding to the forward destination address with respect to which the

confirmation proved unsuccessful, can not be given (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 10, Kubik teaches an E-mail management system according to claim 4, wherein said confirming unit confirms a validity of the already-registered forward destination address after a predetermined period of time has elapsed since the registration thereof, and said forward control unit suspends forwarding to the forward destination address till the confirmation proves successful after the elapse of the predetermined period of time (abstract, Column 7, lines 55-Column 8, lines 30).

As to claim 11, Kubik teaches an E-mail management system according to claim 5, wherein said communication unit receives a request for confirming the already-registered forward destination address from said mail server, and said confirming unit confirms the validity of this forward destination address (abstract, Column 7, lines 55-Column 8, lines 30).

Claims 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 do not teach or define any new limitations other than above claims 1, 3-11. Therefore, claims 14, 16-19, 21-22, 27, 29-37, 40, 42-48, 53, 55-63, 66 and 68-74 are rejected for similar reasons.

### ***Response to Arguments***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***



6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faruk Hamza whose telephone number is 571-272-7969. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll –free).

Faruk Hamza

Patent Examiner

Group Art Unit 2455

/Faruk Hamza/

Examiner, Art Unit 2455